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10/750,046	12/30/2003	Shailendra Garg	OIC0194US	9148
66/975 7590 08/28/2008 CAMPBELL STEPHENSON LLP 11401 CENTURY OAKS TERRACE BLDG. H, SUITE 250 AUSTIN, TX 78758				
EXAMINER				
THOMPSON, MICHAEL M				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/750,046

Applicant(s)

GARG ET AL.

Examiner

Michael M. Thompson

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date ____.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. Claims 1-7 recite a method in a computer system, the method comprising the steps of defining an opportunity class representing an opportunity, the opportunity class identifying a set of relationships of the opportunity with a plurality of entities related to the opportunity. Claims 8-10 recite a method of data transformation comprising receiving data and transforming the data into a format wherein a set of relationships are identified. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63,70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

More specifically, the first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 USC 101: process, machine, manufacture and composition of matter. The latter three categories define "things" or "products", while a "process" consists of a series of steps or acts to be performed. For purposes of 101, a "process" has been given a specialized, limited meaning by the courts.

Based on Supreme Court precedent (*Diamond v Diehr*, 450 U.S. 175,184 (1981); *Parker v. Flook*, 437 US 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions (In re Bilski, Appeal No. 2007-1130), a 101 process must 1) be tied to another statutory class (such as a particular apparatus) or 2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under 35 U.S.C. 101.

For example, all of the recited method steps can be performed by the user themselves or in the mind of the user, and therefor the method steps are not tied to another statutory class, and do not transform the underlying subject matter. The second step is to determine whether the claimed invention falls within a judicial exception (law of nature, natural phenomena, or abstract idea), whether the invention produces a useful, concrete, and tangible result.

In the present case, the above claims only recite an abstract idea. The claims **outline steps to be taken, however this is merely an outline of how a process is intended to work.**

Additionally, for a claimed invention to be statutory, the claimed must produce a useful, concrete, and tangible result. In the present case, the claimed **invention produces a model defining or receiving and transforming data**, the claims are not drawn to something that is concrete and tangible, therefore deemed to be an abstract idea and is not considered to be patent eligible subject matter.

4. With respect to claims 1-7, in particular ***appellants' claim 1 preamble includes only a nominal recitation of a "computer system."*** ***Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process.*** See Benson, 409 U.S. at 71 -72. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Comiskey, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one. *Ex parte Langemyr* (2008).

5. With respect to claims 11-17, applicant's claim 18 reciting "a machine-readable medium" in the preamble, this language is interpreted as including non-statutory subject matter. A review of the specification reveals that, some or all, of the "machine-readable

medium" language may be implemented as a signal. On pages 7-8 and 21 applicant states, for example, "electrical, optical, acoustical or other form of propagated signals (e.g., carrier waves, infrared signals, digital signals, etc.)" This recitation implies that a signal is itself a category that may be included when interpreting the "machine-readable medium" language.

6. Furthermore, with respect to claims 11-17, the "machine-readable medium" language of the preamble, being given the broadest reasonable interpretation, consistent with the specification, does not appear to positively recite actual structure. If the medium were a signal carrying the executable instructions, then the claims do not fall within the statutory classes. If however, the applicant were to state, "machine-readable medium having executable instructions **stored thereon...**" then it is unmistakable that the instructions are actually stored on the medium.

Claim Objections

7. Claims 18-21 are objected to because of the following informalities: Claims 18 and 20 state "at least on processor" and it appears applicant meant to recite "at least one processor". If so, appropriate correction is required.

Specification

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In the claims the terms "means for defining an opportunity class", "means for receiving opportunity data" and "means for transforming the opportunity data" appear to lack support in the specification. With respect to the "means

for defining an opportunity class", "means for receiving opportunity data" and "means for transforming the opportunity data" in claims 22 and 23, 37 CFR 1.75(d)(1) provides, in part, that "the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." In the situation in which the written description only implicitly or inherently sets forth the structure, materials, or acts corresponding to a means- (or step-) plus-function, and the examiner concludes that one skilled in the art would recognize what structure, materials, or acts perform the function recited in a means- (or step-) plus-function, the examiner should either: (A) have the applicant clarify the record by amending the written description such that it expressly recites what structure, materials, or acts perform the function recited in the claim element; or (B) state on the record what structure, materials, or acts perform the function recited in the means- (or step-) plus-function limitation. Even if the disclosure implicitly sets forth the structure, materials, or acts corresponding to a means- (or step-) plus-function claim element in compliance with 35 U.S.C. 112, first and second paragraphs, the USPTO may still require the applicant to amend the specification pursuant to 37 CFR 1.75(d) and MPEP § 608.01(o) to explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, or acts perform the function recited in the claim element. The examiner would like clarification as to which structure, materials, or acts perform the functions as recited in the claims. No new matter should be added.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claim 6 recites the limitation "the data" in lines 4 and 6. There is insufficient antecedent basis for this limitation in the claim. It is unclear if "the data" is the same as the transforming data or the data element of earlier claims.

12. Claims 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. When the examiner considers the "means for" language under sixth paragraph, the scope of the claims is unclear so as not to insure that the public is informed of the boundaries of what constitutes infringement of the patent. Furthermore, it is unclear as to what applicants regard as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C. 112, first paragraph with respect to the claimed invention. MPEP 2173.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-6, 8-13, and 15-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Chin (WO 01143031).

15. **With respect to claim 1**, Chin teaches a method in a computer system for representing a class definition, the method comprising defining an opportunity class representing an opportunity (i.e. Page 7, last paragraph; stored in module 8), the opportunity class identifying a set of relationships of the opportunity with a plurality of entities related to the opportunity.

16. **With respect to claim 2**, Chin teaches the method of claim 1 wherein the plurality of entities related to the opportunity includes entities selected from the group consisting of related accounts, related contact parties, one or more related parent opportunities, related sales employees and consultants, activities associated with the opportunity, a related source organization, a related destination partner, and related revenue. In the least, the "sponsor type" on page 9 recites things such as activities associated with an opportunity, related source organization, designation partner or even the activities associated with revenue, such as the case with the reward system.

17. **With respect to claim 3**, Chin teaches the method of claim 1 wherein the opportunity class includes a custom data element for defining one or more custom data

fields for the opportunity class. (i.e. Custom data and data fields are taught on page 7 or 9, allowing for storage in the project manager module.)

18. **With respect to claim 4**, Chin teaches the method of claim 3 wherein the one or more custom data fields of the opportunity class are specific to an application. (i.e. page 9 at least)

19. **With respect to claim 5**, Chin teaches the method of claim 1 further comprising: instantiating the opportunity class; and initializing data elements of the instantiated opportunity class. It is clear that Chin is using these data elements with respect to the "opportunity class" so that they are used, defined, and executed in a properly functioning referral system.

20. **With respect to claim 6**, Chin teaches the method of claim 5 further comprising, transforming data received from a source application into a common format of the opportunity class; transforming the data from the common format into a target format of a target application; and sending the data in the target format to the target application. It is the examiners position that mapping data is accomplished when, for example, a web browser submits user provided data to a web browser. For example, when a user submits data through an HTTP connection or request, the data is mapped into a data structure on the server. In fact, this is perfect use of XML schema. Therefore, since Chin clearly teaches data structures and elements and further teaches compatible use over the Internet through different interfaces, this function is inherent in any Internet communication including that of Chin.

21. **With respect to claim 8**, Chin teaches a method for data transformation, the method comprising receiving opportunity data from a source application; and transforming the opportunity data into a common format provided by an opportunity class, wherein the opportunity class identifies a set of relationships of an opportunity with a plurality of entities related to the opportunity. Chin teaches the transformation and storage of the information such that the opportunities are stored and the matching providers are based on the relationship of the opportunity. For example, entities interested in a referral for home sales is matched based on similar "opportunity class" and relationship opportunities. It is the examiners position that this claim is merely describing a general matching of a referral. (i.e. the thrust of the Chin reference such as on Page 4.)

With respect to claim 9, Chin teaches the method of claim 8 wherein the plurality of entities related to the opportunity includes entities selected from the group consisting of related accounts, related contact parties, one or more related parent opportunities, related sales employees and consultants, activities associated with the opportunity, a related source organization, a related destination partner, and related revenue. As per claim 9, this claim introduces no substantial limitation over that of claim 2 and is therefore rejected under a similar rational.

22. **With respect to claim 10**, Chin teaches the method of claim 8 wherein the opportunity class includes a custom data element for defining one or more custom data fields for the opportunity class. As per claim 10, this claim introduces no substantial limitation over that of claim 3 and is therefore rejected under a similar rational.

23. **With respect to claim 11**, Chin teaches a machine-readable medium having executable instructions to cause a machine to perform a method comprising, defining an opportunity class representing an opportunity, the opportunity class identifying a set of relationships of the opportunity with a plurality of entities related to the opportunity. As per claim 11, this claim introduces no substantial limitation over that of claim 1 and is therefore rejected under a similar rational.

24. **With respect to claim 12**, Chin teaches the machine-readable medium of claim 11 wherein the plurality of entities related to the opportunity includes entities selected from the group consisting of related accounts, related contact parties, one or more related parent opportunities, related sales employees and consultants, activities associated with the opportunity, a related source organization, a related destination partner, and related revenue. As per claim 12, this claim introduces no substantial limitation over that of claims 2 and 9 and is therefore rejected under a similar rational. i.e. The Chin reference, in the least, teaches the use of computers on pages 9 and 18.

25. **With respect to claim 13**, Chin teaches the machine-readable medium of claim 11 wherein the opportunity class includes a custom data element for defining one or more custom data fields for the opportunity class. As per claim 13, this claim introduces no substantial limitation over that of claim 3 or 10 and is therefore rejected under a similar rational.

26. **With respect to claim 15**, Chin teaches a machine-readable medium having executable instructions to cause a machine to perform a method comprising, receiving opportunity data from a source application; and transforming the opportunity data into a

common format provided by an opportunity class, wherein the opportunity class represents an opportunity and identifies a set of relationships of the opportunity with a plurality of entities related to the opportunity. It is inherent that Chin's computer systems have executable instructions or software to perform the function. As per claim 15, this claim introduces no substantial limitation over that of claim 6 and/or 8 and is therefore rejected under a similar rational.

27. **With respect to claim 16**, Chin teaches the machine-readable medium of claim 15 wherein the plurality of entities related to the opportunity includes entities selected from the group consisting of related accounts, related contact parties, one or more related parent opportunities, related sales employees and consultants, activities associated with the opportunity, a related source organization, a related destination partner, and related revenue. As per claim 16, this claim introduces no substantial limitation over that of claims 2, 9, or 12 and is therefore rejected under a similar rational.

28. **With respect to claim 17**, Chin teaches the machine-readable medium of claim 15 wherein the opportunity class includes a custom data element for defining one or more custom data fields for the opportunity class. As per claim 17, this claim introduces no substantial limitation over that of claims 3, 10 or 13 and is therefore rejected under a similar rational.

29. **With respect to claim 18**, Chin teaches a system comprising: a memory; and at least on processor coupled to the memory, the processor executing a set of instructions which cause the processor to define an opportunity class representing an opportunity, the opportunity class identifying a set of relationships of the opportunity with a plurality

of entities related to the opportunity. As per claim 15, this claim introduces no substantial limitation over that of claim 1 and/or 11 and is therefore rejected under a similar rational. It is inherent that Chin's computer systems have a processor with memory to perform the function. (i.e. The Chin reference, in the least, teaches the use of computers on pages 9 and 18.)

30. **With respect to claim 19**, Chin teaches the system of claim 18 wherein the plurality of entities related to the opportunity includes entities selected from the group consisting of related accounts, related contact parties, one or more related parent opportunities, related sales employees and consultants, activities associated with the opportunity, a related source organization, a related destination partner, and related revenue. As per claim 19, this claim introduces no substantial limitation over that of claims 2, 9, 12 or 16 and is therefore rejected under a similar rational.

31. **With respect to claim 20**, Chin teaches a system comprising: a memory; and at least on processor coupled to the memory, the processor executing a set of instructions which cause the processor to receive opportunity data from a source application, and transform the opportunity data into a common format provided by an opportunity class, wherein the opportunity class represents an opportunity and identifies a set of relationships of the opportunity with a plurality of entities related to the opportunity. As per claim 20, this claim introduces no substantial limitation over that of claim 6, 8 and/or 15 and is therefore rejected under a similar rational.

32. **With respect to claim 21**, Chin teaches the system of claim 20 wherein the plurality of entities related to the opportunity includes entities selected from the group

consisting of related accounts, related contact parties, one or more related parent opportunities, related sales employees and consultants, activities associated with the opportunity, a related source organization, a related destination partner, and related revenue. As per claim 21, this claim introduces no substantial limitation over that of claims 2, 9, 12, 16 or 19 and is therefore rejected under a similar rational.

33. **With respect to claim 22**, Chin teaches an apparatus for representing a class definition, the apparatus comprising: means for defining an opportunity class representing an opportunity of different types, the opportunity class identifying a set of relationships of the opportunity with a plurality of entities related to the opportunity. As per claim 22, this claim introduces no substantial limitation over that of claims 1, 8 and/or 11 and is therefore rejected under a similar rational. Please not the objections and rejections with respect to the means language.

34. **With respect to claim 23**, Chin teaches an apparatus for data transformation, the apparatus comprising: means for receiving opportunity data from a source application; and means for transforming the opportunity data into a common format provided by an opportunity class, wherein the opportunity class represents the opportunity and identifies a set of relationships of the opportunity with a plurality of entities related to the opportunity. As per claim 23, this claim introduces no substantial limitation over that of claim 6, 8, 15 and/or 20 and is therefore rejected under a similar rational. Please not the objections and rejections with respect to the means language.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

35. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chin (WO 01143031).

36. With respect to claims 7 and 14, Chin teaches the method of claim 1 wherein a definition of the opportunity class is represented as an XML schema. The examiner takes Official Notice that XML schema is well known in data structures and its primary purpose is to help information systems share structured data, particularly via the Internet and internet based communication. Therefore, it would have been obvious to

one of ordinary skill in the art, at the time of invention, to have utilized XML Schema to share structured data.

Conclusion

37. The Examiner has pointed out particular references contained in the prior art of record, within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael M. Thompson whose telephone number is (571) 270-3605. The examiner can normally be reached on Monday thru Friday 8am-5:30 except Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael M Thompson/
Examiner, Art Unit 3629
August 26, 2008

/John G. Weiss/
Supervisory Patent Examiner, Art Unit 3629